

REMARKS

Claims 1-8 are pending. By this Amendment, claim 8 is amended to recite that the light guiding member and the light conductive member are formed integrally from a one-piece member, to distinguish Abe. No new matter is added. Reconsideration of the application is respectfully requested.

The attached Appendix includes marked-up copies of each rewritten claim (37 C.F.R. §1.121(c)(1)(ii)).

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issue requiring further search and/or consideration (since the amendments amplify issues previously discussed throughout prosecution); and (c) place the application in better form for appeal, should an appeal be necessary. Entry of the amendments is thus respectfully requested.

Applicants thank Examiner Sawhney for the courtesy extended to Applicants' representative, Mr. Luo, during the January 15 and 28 telephone interviews. The substance of the interviews is incorporated in the Remarks below.

The Office Action rejects claim 8 under 35 U.S.C. §102(b) over U.S. Patent No. 5,857,761 to Abe et al. This rejection is respectfully traversed.

The Office Action asserts that Abe discloses the subject matter recited in claim 8. However, Applicants respectfully submit that Abe does not disclose that the light guiding member and the light conductive member are formed integrally from a one-piece member, as recited in claim 8.

Abe discloses a light guide 2 that is connected to a radiation member 3. See Fig. 1 and col. 5, lines 25-41. The light guide 2 and the radiation member 3 are made of different materials. See col. 5, lines 25-41. Thus, as discussed in the telephone interviews, Abe's light guide 2 and radiation member 3 are not formed integrally from a one-piece member.

Therefore, Abe does not disclose that the light guiding member and the light conductive member are formed integrally from a one-piece member, as recited in claim 8.

Furthermore, in the telephone interviews, the Examiner suggested that the subject matter recited in claim 8 may be rendered obvious by Abe. However, Abe does not suggest or provide any motivation to one of ordinary skill to use the same material for the light guide 2 and the radiation member 3, and to form these two elements from a one-piece member. As is well known, forming these elements from a one-piece member as opposed to two separate pieces made of different materials results in large differences in areas such as manufacturing, for example. Thus, one of ordinary skill in the art would not be motivated to make the modification, unless there are explicit teachings to do so. Thus, one of ordinary skill in the art would not be motivated by Abe alone to change the different materials taught by Abe and use a single material, and change combining two pieces formed separately to forming from one piece the combined two-piece structure of Abe. In fact, Abe teaches away from the subject matter recited in claim 8. Accordingly, Abe would not have rendered obvious the subject matter recited in claim 8.

For at least the above reasons, Abe does not disclose each and every element recited in claim 8, nor does Abe suggest the subject matter recited in claim 8. Accordingly, withdrawal of the rejection of claim 8 under 35 U.S.C. §102(b) is respectfully requested.

The Office Action rejects claims 1-7 under 35 U.S.C. §103(a) over Abe in view of U.S. Patent No. 6,431,716 to Kusakabe. Applicants respectfully submit that this rejection is improper.

Applicants respectfully submit that Kusakabe has the same assignee (Minebea Co., Ltd.) as the above-identified application. Thus, as discussed in the telephone interviews, Kusakabe cannot be applied as a §103/§102(e) reference under 35 U.S.C. §103(c), which states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of §102 of this


title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

For at least the above reasons, withdrawal of the rejection of claims 1-7 under 35 U.S.C. §102(b) is respectfully requested.

In view of the foregoing amendments and remarks, Applicants submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-8 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,



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Attachment:  
Appendix

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## APPENDIX

## Changes to Claims:

The following is a marked-up version of the amended claim:

8.     (Amended) A spread illuminating apparatus having a bar-like light source disposed in the vicinity of an end surface of a transparent substrate made of a light transmissible material, characterized in that said bar-like light source is composed of a light conductive member which is made of a transparent material, formed bar-like and disposed close to and along at least one end face of said transparent substrate, and a spot-like light source which is disposed facing at least one end of said light conductive member, and that a light guiding member guiding light is provided between the end of said light conductive member and said spot-like source;

wherein said light guiding member and said light conductive member are formed integrally as from a one-piece member.